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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,678	03/03/2004	Matthew Rubin Lerner	5486-0128PUS3	2303
67321 7590 02/21/2008 BIRCH, STEWART, KOLASCH & BIRCH, LLP 8110 GATEHOUSE ROAD SUITE 100 EAST FALLS CHURCH, VA 22040-0747				
EXAMINER VAUGHN, GREGORY J				
ART UNIT 2178		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,678

Applicant(s)

LERNER ET AL.

Examiner

GREGORY J. VAUGHN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 5, 7, 8, 10, 11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 8, 10, 11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Action Background

1. This action is responsive to the amendment after final, filed 1/17/2008.
2. Applicant has added new claims 15-21. Claims 3, 6, 9 and 12 were previously canceled.
3. Claims 1, 2, 4, 5, 7, 8, 10, 11 and 13-21 are pending in the case; claims 1, 7 and 15 are independent claims.
4. The examiner's rejection of claims 1, 2, 4, 7, 8, 10, 13 and 14, rejected under 35 USC 102(e), as being anticipated by Gupta et al. US Patent 6,956,593, as recited in the previous office action (dated 10/17/2007), are withdrawn in view of the applicant's remarks, however, new grounds of rejection are made, as described below.
5. The examiner's rejection of claims 5 and 11, rejected under 35 USC 103(a), as being unpatentable in view of Gupta et al. US Patent 6,956,593, as recited in the previous office action (dated 10/17/2007), are withdrawn in view of the applicant's remarks, however, new grounds of rejection are made, as described below.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 5, 7, 11 and 13-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Lopresti et al. US Patent 5,832,474, filed 2/26/1996, patented 11/3/1998 (hereinafter Lopresti).
8. **Regarding independent claim 1**, Lopresti is directed toward a document search and retrieval system that provides a user annotation capability that includes user drawn annotations (see title and abstract). Lopresti document capability includes web based documents. Lopresti recites: *"the document database can also store documents that are generated by software applications such as word processors, multimedia authoring applications, graphic illustration applications, computer-aided design applications, spreadsheet applications, on-line and network-based applications (such as those generating documents for the World Wide Web, in HTML or the like). These applications may run on one or more workstations connected to network 14. The document database may be distributed over a number of machines, or over a local or wide area network"* (column 4, lines 56-66).

Lopresti discloses a database of documents, as described above. Lopresti discloses that the database is searchable, and that the documents are annotated. Lopresti recites: *"the invention relates to a document annotation, search and retrieval system that supports searchable user-drawn annotations"* (column 1, lines 9-11). Lopresti discloses that the database stores annotation attribute values that are searchable. Lopresti recites: *"Using a digitizing pen or other suitable drawing device, the user electronically draws annotations that are electronically displayed on and stored with a selected document within the database. The search engine is able to locate the annotated document in response to a user-drawn query by a partial match searching technique. The partial match searching technique compares temporal and spatial components of the user-drawn annotations"* (column 1, lines 11-19).

Lopresti discloses a search result that is a subset of the documents and displaying the result as thumbnail images. Lopresti recites: *"In this way, a sorted list comprising all or the n-best matches is displayed in the thumbnail sketches of the main browser screen"* (column 11, lines 50-52) and *"In FIG. 2 the image of a selected document is displayed in display window 24. For illustration purposes here, an image of document 32 is displayed. At the upper right-hand segment of the screen 36 there is a series of thumbnail sketches of various document pages that have been located by the search engine for selection by the user"* (column 5, lines 19-25).

9. **Regarding dependent claim 5**, Lopresti discloses the search result having at least two documents, and displaying the result as thumbnail images. Lopresti recites: *"In this way, a sorted list comprising all or the n-best matches is displayed in the thumbnail sketches of the main browser screen"* (column 11, lines 50-52).
10. **Regarding claims 7 and 11**, the claims are directed toward a computer readable media for the method of claims 1 and 5, respectively, and are rejected with the same rationale.
11. **Regarding dependent claims 13 and 14**, Lopresti discloses that the search criteria is input by a user. Lopresti recites: *"The search engine is able to locate the annotated document in response to a user-drawn query by a partial match searching technique"* (column 1, lines 15-17).
12. **Regarding independent claim 15**, the claim is directed toward a method for the method of claim 1 and is rejected using the same rationale. Claim 15 is further directed toward the annotation data is stroke data representing electronic ink and the searching is based on the stroke data. Lopresti discloses storing and searching based on the electronic ink stroke data. Lopresti recites: *"Using a digitizing pen or other suitable drawing device, the user electronically draws annotations that are electronically displayed on and stored with a selected document within the database. The search engine is able to locate the annotated document in response to a user-drawn query by a partial match searching technique. The partial match searching technique*

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compares temporal and spatial components of the user-drawn annotations"
(column 1, lines 11-19).

13. **Regarding dependent claims 16 and 17**, Lopresti discloses the attributes of the stroke data being a list of coordinate points and elapsed time from start to end of a stroke. Lopresti recites: *"Illustrated in FIG. 5, the user-drawn query 100 is captured as a string of (X,Y) ink points, corresponding to the motion of the pen tip over the surface of the digitizing tablet or pad as the user draws query 100. The presently preferred embodiment digitizes this information by sampling the output of the digitizing pad at a predetermined sampling rate. Although a fixed sampling rate is presently preferred, the invention can be implemented using a variable sampling rate, as well. By virtue of the digitized capture of the X,Y position data, both spatial and temporal components of the user-drawn pen strokes are captured"* (column 9, lines 9-20).
14. **Regarding dependent claim 18**, Lopresti discloses the search criteria as electronic ink input, and searching based upon the electronic ink input stroke, as described above.
15. **Regarding dependent claim 19**, Lopresti discloses using a visual characteristic of the search input to search the database for comparable visual characteristics. Lopresti discloses capturing (x,y) ink points as spatial data as described above. The (x,y) ink points describe the visual characteristics of the user drawn stroke data.

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16. **Regarding dependent claim 20**, Lopresti discloses a thumbnail image, as described above.
17. **Regarding dependent claim 21**, the claim is directed toward a method for the method of claim 5, and is rejected using the same rationale.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

19. Claims 2, 4, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of Bays et al., US Patent 6,219,603, filed 10/28/1999, patented 2/11/2003 (hereinafter Bays).
20. **Regarding dependent claims 2, 4, 8 and 10**, Lopresti discloses searching annotated documents to obtain a subset of annotated documents, and displaying a thumbnail image of the document, as described above. Lopresti fails to disclose storing attributes related to the author of the annotation or storing a website associated with the document. Bays discloses an annotation system that provides a query function related to the

annotations. Bays discloses storing attributes associated with the annotation author and the annotation date. Bays recites: *"In the example of FIG. 2, the administrator 27 defines the annotation structure by identifying the desired categories and the order in which the annotation content will be entered and/or displayed. For illustration purposes, the annotation structure for cell 75 includes three categories: The first category 77 represents the annotation author's category, and provides information (in the form of annotations), for instance, about the author's name, the context or author's discipline, and the entry date"* (column 9, lines 11-19). Bays discloses storing attribute associated with a web site. Bays recites: *"It should be understood that the foregoing capabilities encompass a single annotation structure containing an attribute such as "Comment" or "URL" for every annotatable data item"* (column 3, lines 34-37).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine the user-drawn annotation system of Lopresti with the annotation structure of Bays to provide *"a method and system having the capability to organize an annotation structure and to query both data and annotations in computer systems"* (Bays, column 1, lines 8-11).

Response to Arguments

21. Applicant's arguments with respect to claims 1, 2, 4, 5, 7, 8, 10 and 11 have been considered but are moot in view of the new ground(s) of rejection, as described above.
22. Applicant's arguments, see pages 7-10 of the response filed 1/17/2008, with respect to the rejection(s) of claim(s) 1, 2, 4, 5, 7, 8, 10, 13 and 14, rejected under 35 USC 102(e) or 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Lopresti, or Lopresti in view of Bays, as described above.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Gregory J. Vaughn/
Patent Examiner
February 8, 2007

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178